

The Drawings, Specification and Claims have been amended to conform to conventional practice and form. Examiner may note that the Drawings and Specifications have been amended to better describe previously disclosed elements which may be included within a cushion assembly.

In light of Examiner's 35 U.S.C. § 102 rejection and accompanying responses, the following argument is respectfully presented and of which clearly merits Examiner's allowance in this Application. Accordingly, Examiner evokes the "Identity of Invention" test for anticipation. Bristol-Meyers Squibb Co. v. Danbury Pharmacal Inc., 28 USPQ2d 1947, 1949 (S.D.N.Y. 1993). Identity of invention is a question of fact and one who seeks such finding must show, by a high burden of proof, that each element of the claim in issue is found either expressly or under the principles of inherency, in a single prior art reference, or that the claimed invention was previously known or embodied in a single prior art device or practice. Geffner v. Linear Rotary Bearings, Inc., 936 F.Supp. 1150, 1180 (E.D.N.Y. 1996). Inherency is a modest flexibility in the rule for anticipation. It is not, however, a substitute for determining patentability in terms of § 103. Continental Can Co. U.S.A., Inc. v. Monsanto Co., 948 F.2d 1264, 1269 (Fed. Cir. 1991). Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. Geffner v. Linear Rotary Bearings, 948 F.Supp. at 1181 (E.D.N.Y. 1996); see also Interchemical Corp. v. Watson, 145 F.Supp. 179, 182 (D. D.C. 1956). To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such a gap in the reference may be filled with extrinsic recourse. Continental Can Co. U.S.A., Inc. v. Monsanto Co., 948 F.2d at 1268 (Fed. Cir. 1991). Such an extrinsic determination requires looking at the specification, other claims and prosecution history for that single reference. Minnesota Mining and Manufacturing v. Johnson & Johnson, 24 U.S.P.Q. 1321, 1328 (Fed. Cir. 1992). Absence from the prior art reference of any claimed element negates anticipation. Id. at 1332. It should also be noted that a relatively high burden of proof is required to show an anticipated reference contains each and every element and limitation of the claims of that single prior art reference. Hoover Group Inc. v. Custom Metalcraft Inc., 36 U.S.P.Q.2d 1101, 1103 (Fed. Cir. 1995); see also Stirling-White Co. Inc. v. Emerson Electric Co., Inc., 34 U.S.P.Q.2d 1077, 1079 (D.E. Mich. 1994); Liposome Co. v. Vester Inc., 36 U.S.P.Q.2d 1295, 1312 (D.Del 1994); and Marion Merrel

Dow Inc. v. Geneva Pharmaceuticals Inc., 33 U.S.P.Q. 2d 1673, 1676 (D.Colo. 1994). Also, when more than one reference is required to establish unpatentability of the claimed invention, anticipation cannot be found. Geffner v. Linear Rotary Bearings, Inc., 936 F.Supp. at 1181 (E.D.N.Y. 1996).

Accordingly, the Identity of Invention test is improperly applied against the teachings of the Law such that each of the cited prior art references, Pupovic '929, Failor et al. '260 and Peck '259, allegedly anticipate the present invention by each having an allegedly inherent ability to functionally support patients having weights of about 500 to 800 pounds. Clearly, inherency may not be established by probability or possibility and that the mere fact that a certain thing may result from a given set of circumstances is not sufficient. Moreover, the specification and claims of each of the cited references do not extrinsically disclose the ability to support patients having weights of about 500 to 800 pounds -- not even for a brief moment as contemplated in the rejection. For example, Pupovic '929 goes as far as extrinsically disclosing in the specification that the '929 invention "concerns a bed intended for persons either ill or on rehabilitation" but does not include each and every element and limitation for bariatric patients as in the present invention. Therefore, Pupovic '929, Failor et al. '260 and Peck '259 do not anticipate the present invention, inherently or otherwise.

Amended Claim 1 is responsive to Examiner's objection to Claim 1's prior recitation of the text that an element is "adapted to" perform a function. The amended Claim 1 sets forth the disputed element as a positive limitation by excluding the phrase "adapted to". It should also be known that the law does provide for the phrase "adapted for" as a limitation. In re Laud and Rogers, 151 U.S.P.Q. 621 (C.C.P.A. 1966). Moreover, terms appearing in the preamble may be deemed limitations of a claim when they give meaning to the claim and properly define the invention. In re Paulsen, 30 F.3d 1475, 1479 (Fed. Cir. 1994); Application of Benner et al., 174 F.2d 938, 943 (C.C.P.A. 1949). Consequently, the bariatric patient weight range of about 500 to 800 pounds must be a positive limitation so as to properly give meaning and purpose to the invention. Otherwise, without applying such bariatric limitations to the bed devices of the cited prior art, such devices would neither be functional nor fully enabling because, as admitted by Examiner, they would break in a very short period of time. In this light, new use and physical properties associated with the bariatric range for this present invention must be considered as a

limitation. MPEP § 608.04(a) (6th ed., rev. 2, 1996) (characteristics such as physical properties or a new use may be new matter); Ex parte Vander Wal, 705 O.G. 5, 7 (1956); and Ex parte Ayers, et al., 108 U.S.P.Q. 444. Thus, such a bariatric limitation differentiates and does not anticipate the claimed invention from the prior art. Indeed, the structural limitations of the present invention are clearly not anticipated by the structural limitations of the cited prior art.

Since Applicant accords the Examiner full faith and credit for conducting the prior art search in full compliance with the guidelines as set forth in MPEP Chapter 900, these minor modifications should pose no substantive new issues which would preclude the entry of said matter after final rejection.

REQUEST FOR RECONSIDERATION

In view of the above discussion, it is respectfully submitted that the presently pending claims of this application are not anticipated by any one of the cited references of record. Therefore, favorable reconsideration of this application, as amended, is respectfully requested as a Notice of Allowance issued thereon.

Respectfully submitted,

KINETIC CONCEPTS, INC.
P.O. Box 659508
San Antonio, Texas 78265-9508
(210) 225-7386
(210) 225-4285 (Fax)

William H. Quirk, IV
Reg. No. 33,996

EXPRESS MAIL Mailing label No. 1B848574408
Date of Deposit 6/1 5/20 1997
I hereby certify that this paper or fee is being
deposited with the United States Postal Service "Ex-
p. 1 Post Office to Addressee" service under 37 CFR
0 on the date indicated above and is addressed to the
Commissioner of Patents and Trademarks, Washington
D.C. 20591